

REMARKS

Claims 1-7, 9, and 10 are pending in the present application.

In the Notice of Non-Compliant Amendment mailed on July 10, 2006, the Office states that the amendment filed on April 25, 2006, still does not comply with the requirements of 37 C.F.R. §1.121. The new criticism is that the amendment “effectively directs the claim to non-elected subject matter as a sequence of 15-19 bases is shorter than that of SEQ ID NO: 8.” Applicants disagree with the Examiner’s assertion that such an amendment would render the amendment filed on April 25, 2006, non-compliant.

The Examiner is reminded that the Office Communication mailed October 4, 2004, the Office required an election of species as follows:

Species I: a pair of primers including SEQ ID NOs: 7 and 8, and methods of employing that pair of primers (e.g., claims 2-3 and 7-8), and

Species II: a pair of primers including SEQ ID NOs: 9 and 10, and methods of employing that pair of primers (e.g., claims 5-6 and 9-10).

In making this election of species requirement, the Examiner acknowledged that Claims 1 and 4 are generic (see MPEP §806.04(d) for definition). Further, it was acknowledged that “upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.”

The amendment filed on April 25, 2006, served to more particularly and properly define the second primer (i.e., primer (ii)) in Claim 1 in view of the disclosure on page 9, line 1 to page 12, line 2. Specifically, the amendment filed on April 25, 2006, defined the second primer as a “primer comprising 15-30 bp of a sequence that is complementary to a base

sequence of chromosome IX of *Saccharomyces cerevisiae* located downstream from a sequence selected from the group consisting of SEQ ID NO: 1, SEQ ID NO: 2, SEQ ID NO: 3, SEQ ID NO: 4, SEQ ID NO: 5, and SEQ ID NO: 6” (see Claim 1). As stated above, it is the introduction of the range of 15-19 nucleotides that the Examiner has taken objection to. However, it should be noted that the primer size in original Claim 1, which was subject to the election of species requirement, did not specify the size of the second primer. As such, the claim as originally presented embraced smaller primer sizes than 15-19 nucleotides, as well as those greater than 20-30 nucleotides. Also, it should be noted that original Claim 1 also contained the language “portion of yeast chromosome IX linked downstream from” as its only locational parameter, which is consistent with Claim 1 presented on April 25, 2006. Therefore, the scope of the second primer after the response filed on April 25, 2006, actually defines a narrower genus than that of original Claim 1.

Further, amended Claim 1 remains generic to the elected species of SEQ ID NO: 8. In fact, the Examiner recognizes as much in the Notice of Non-Compliant Amendment (lines 5-6 of the Continuation of 4(e)). The remaining criticisms by the Examiner that the “claim fairly encompasses any and all manner of sequence downstream of SEQ ID NO: 2-6, not just SEQ ID NO: 8” is irrelevant. There is nothing in the rules that prohibit the amendment as set forth herein, much as there is no requirement that Applicant must narrow the scope of a generic claim to the specifically elected species by excluding any and all other members of the genus. Yet, this is the sole basis offered by the Examiner in the Notice of Non-Compliant Amendment.

However, Applicants submit that the contrary of the Examiner’s assertion is correct. Upon a finding of allowability of the elected species the Office should expand its search to the non-elected species embraced by the claimed genus. Therefore, it is absolutely proper to

maintain the generic claim. This is especially true where the scope of the genus is largely unchanged or is narrowed with respect to the genus that was subject to the original election of species requirement.

The only way in which the response filed on April 25, 2006, could be non-compliant is if the claims were amended to exclude the elected species (i.e., SEQ ID NO: 8) from the scope of the pending claims. This is not the case here. As stated above, the Examiner recognizes and states on the record that amended Claim 1 *does read on the elected species* of SEQ ID NO: 8. Therefore, the response filed on April 25, 2006, is fully compliant.

Applicants submit that the present application is now in condition for further examination. It is respectfully requested that the Office acknowledge such action without any further needless delay. Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/03)